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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,828	05/10/2001	Rabindranath Dutta	US920010333US1	5441
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IBM CORP (BLF) c/o BIGGERS & OHANIAN, LLP 504 LAVACA STREET, SUITE 970 AUSTIN, TX 78701-2856			ROSEN, NICHOLAS D	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/852,828

Applicant(s)

DUTTA ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-24, 26-38 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10, 14-24, 28-35, 37, 38 and 42 is/are rejected.
- 7) ☒ Claim(s) 8, 12, 13, 22, 26, 27, 36, 40 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-10, 12-24, 26-38, and 40-42 have been examined.

#### ***Claim Objections***

Claims 15-28 are objected to because of the following informalities: In the eighth line of claim 15 (line 7 on page 19), "the destination country" lacks antecedent basis. Appropriate correction is required.

Claims 29-42 are objected to because of the following informalities: It is questionable whether data on a recording medium, as such, can be considered "means for," and even if the data as such can be called "means for", the claim elements might be met by instructions telling a human being to perform the indicated actions, and such instructions are not patentable, being merely non-functional descriptive material. (Examiner has noted that the preamble of claim 29 recites, "A computer program product", but this could mean merely a computer program which causes a computer to print a set of instructions for a human being to carry out, the human being not using that computer in the process.) If applicants wish to claim a computer program, preferred claim language is, "A computer program product, embodied on a computer-readable medium, the computer program product comprising computer-implementable instructions for causing a computer to carry out the steps of: doing A; doing B; and doing C." Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-7, 9-10, and 14**

Claims 1, 2, 4, 5, 6, 7, 9, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandyk ("No Entry") in view of official notice. As per claim 1, Vandyk discloses a method for facilitating international travel, the method comprising: creating a travel record; creating in dependence upon the travel record, an immigration admissions form for a destination country; and submitting the immigrations admissions form to an immigration admission forms database for the destination country (three paragraphs beginning from "The Blue system differs from the Green"). Vandyk does not disclose that the travel record is stored on or within an international travel server, or that

the travel record is created in response to a signal communicated through an internet-enabled device coupled for data communications through at least one internet connection to an international travel server, but does disclose transmitting passenger information electronically (ibid.). Official notice is taken that servers are well known; hence it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention to have the passenger information electronically transmitted from a server, which would therefore be an international travel server, for the obvious advantage of achieving the electronic transmission by convenient, widely available hardware and software.

Vandyk discloses validating a travel record against enforcement data in databases (three paragraphs beginning from "The Blue system differs from the Green"), and therefore, by implication, against admissions rules stored in an admissions rules database (in the sense that "Don't admit identified criminals or persons with incorrect documents" is an admission rule).

Official notice is further taken that it is well known to communicate signals through internet enabled devices coupled for data communications through at least one internet connection to a server (e.g., any sort of client, such as a PC, communicating with an Internet server). Hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention to create the travel record in response to a signal communicated through an internet-enabled device coupled for data communications through at least one internet connection to an international travel server, for the obvious advantage of enabling data to be

conveniently provided by a passenger not present (or not yet present) to supply information to the airline or other APIS participant in person.

As per claim 2, Vandyk does not disclose that the internet-enabled device is a workstation in a kiosk at an airport, but official notice is taken that workstations in kiosks are well known, and that kiosks at airports are well known; hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention for the internet-enabled device to be a workstation in a kiosk at an airport, for the obvious advantage of enabling travelers in airports to conveniently provide information to the travel server.

As per claim 4, Vandyk does not disclose that the internet-enabled device is a personal computer, but official notice is taken that personal computers are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention for the internet-enabled device to be a personal computer, for the obvious advantage of enabling passengers, or prospective passengers, to conveniently provide information to the travel server from their homes or other locations at which PC's might be located.

As per claim 5, Vandyk does not disclose that the internet-enabled device is a hand-held personal data administrator, but official notice is taken that hand-held personal data administrators (aka PDA's, personal digital assistants, etc.) are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention for the internet-enabled device to be a hand-held personal data administrator, for the obvious advantage of

enabling passengers, or prospective passengers, to conveniently provide information to the travel server from wherever they might be.

As per claim 6, Vandyk does not disclose the at least one internet connection is wireless, but official notice is taken that it is well known for internet connections to be wireless. Hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention for the at least one internet connection to be wireless, for the obvious advantage of enabling passengers, or prospective passengers, to conveniently communicate with the travel server from locations which did not happen to be connected to the travel server by wires.

As per claim 7, Vandyk discloses travel data describing travel, the travel data including identification of a traveler (three paragraphs beginning from "The Blue system differs from the Green"). Vandyk does not disclose that the travel data includes identification of a destination country, but from context, a destination country would be identified or implied (the "complete passenger manifest" would presumably identify the flight, e.g., Flight 1234 from Heathrow Airport, UK, to Dulles International Airport, U.S.A., identifying or implying the destination country).

As per claim 9, Vandyk does not expressly disclose reading travel data from a travel record and inserting the read travel data into an immigration admissions form, but this is merely routine data handling; official notice is taken that it is well known to read data from one record and insert it into another. Hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention to read travel data from a travel record and insert the read travel data into an

immigration admissions form, for the obvious advantage of making data available in the preferred form.

As per claim 10, Vandyk does not disclose that submitting the admissions forms to an admissions form database for the destination country comprises communicating the forms as electronic data communication through at least one internet connection but does disclose communicating the information electronically (paragraph beginning "Participating airlines, as well as cruise lines"). Official notice is taken that it is well known for electronic communication to be internet communication through at least one internet connection. Hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention for the electronic communication to be communication over at least one internet connection, for the obvious advantage of communicating the information using standard, readily available equipment.

As per claim 14, Vandyk does not expressly disclose a travel record form dependent on admissions rules, but does disclose transmitting information including the passenger's name, birth date, passport number, and nationality, to comply with government rules (paragraph beginning "Participating airlines, as well as cruise lines"), which implies a travel record containing this information, to comply with government rules.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vandyk and official notice as applied to claim 1 above, and further in view of Crandall et al. (U.S. Patent Application Publication 2002/0109647). Vandyk does not disclose that the



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internet-enabled device is a workstation installed in the back of a passenger chair in an airplane, but Crandall teaches workstations installed in the backs of passenger chairs in an airplane (Abstract; Figures 1 and 3; paragraphs 0005, 0012, 0015, 0016, 0017, 0020, and 0023). Hence, it would have been obvious to one of ordinary skill in the art of electronic communication at the time of applicant's invention for the internet-enabled device to be a workstation installed in the back of a passenger chair in an airplane, for the obvious advantage of enabling information to be communicated from an airplane where a passenger was flying.

**Claims 15-21, 23-24, and 28**

Claims 15-21, 23-24, and 28 are closely parallel to claims 1-7, 9-11, and 14, and rejected under 35 U.S.C. 103(a) on essentially the grounds set forth above, based on Vandyk and official notice (and Crandall et al. in the case of claim 17).

**Claims 29-35, 37-38, and 42**

Claims 29-35, 37-38, and 42 are closely parallel to claims 1-7, 9-11, and 14, and rejected under 35 U.S.C. 103(a) on essentially the grounds set forth above, based on Vandyk and official notice (and Crandall et al. in the case of claim 31).

***Allowable Subject Matter***

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Likewise, claims 22 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further rewritten to overcome the objection made to claims 15 and 29, respectively.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Vandyk ("No Entry") discloses or makes obvious the limitations of claim 1, as set forth above. Vandyk further discloses submitting to immigration databases immigration admissions forms prepared in dependence upon the travel records (three paragraphs beginning from "The Blue system differs from the Green"). It is well known for a server to be or comprise a software application stored on one or more computers. However, Vandyk does not disclose the travel server validating travel described in travel records against admission rules stored in admission rules databases, nor does any other prior art of record. In Vandyk, such validation is carried out by the Customs Service and/or other authorities based on information received from what may be considered a travel server.

Claims 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Likewise, claims 26 and 27, and 40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form

including all of the limitations of the base claim and any intervening claims, and further rewritten to overcome the objection made to claims 15 and 29, respectively.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Vandyk ("No Entry") discloses or makes obvious the limitations of claim 1, as set forth above, and further discloses comparing travel data to admissions rules (in the sense that "Don't admit identified criminals or persons with incorrect documents" is an admission rule). However, Vandyk does not disclose reporting to the traveler through an internet-enabled device a result of the comparison, nor does any other relevant prior art of record. Instead, Vandyk teaches dealing with passengers on the basis of the comparison once they arrive at their destination. It is known to return data to users through internet-enabled devices, but that is held to be insufficient to make the claimed limitation obvious. It is held to be reasonable to combine Vandyk with communicating a signal through an internet-enabled device and internet connection, but adding reporting a result to the traveler through that internet-enabled device is a major departure from Vandyk's teaching, without motivation in the prior art.

### ***Response to Arguments***

Applicant's arguments filed December 17, 2004 have been fully considered but they are not persuasive. Applicant has respectfully proposed that the independent claims are now allowable, having been amended to incorporate the allowable subject matter from certain dependent claims which were found potentially allowable; but

Examiner must respectfully point out that Applicant's claims, as amended, do not correspond to what was found to be allowable.

"Validating" is not sufficient to make the claims non-obvious over Vandyk, which implies such validating by disclosing comparing records to enforcement databases. The potentially patentable distinction made by Examiner regarding claim 8 is that Vandyk does not disclose the travel server validating travel described in travel records against admission rules stored in admission rules databases. Claim 1, as amended does not include any limitation that the travel server performs the validating. Moreover, it would be advisable to recite explicitly that the travel server is external to the destination country's immigration authority, to whose database the travel server submits the admission form, so that the independent claims could not be read as describing the operations of an immigration authority's computer system.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pool et al. (U.S. Patent 6,460,020) disclose a universal shopping center for international operation. Zagami (U.S. Patent 6,801,907) discloses a system for verification and association of documents and digital images. Fujimura (U.S. Patent

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6,842,741) discloses a recording medium with electronic ticket definitions recorded thereon and electronic ticket processing methods and apparatuses.

McClelland et al. (U.S. Patent Application Publication 2005/0031076) disclose a remote baggage screening method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. This is scheduled to change to 571-272-6762 on or about April 13, 2005. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*

**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

March 2, 2005